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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,193	12/21/2000	Rudolph W. Frey	24430.9	7612

7590 05/20/2002

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

02/745,193

Applicant(s)

Frey et al

Examiner

J. Shay

Group Art Unit

3739

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on February 4, 2002
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on 2/4/02 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3739

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sklar et al.

Sklar et al teach an eye surgical tracking device (see abstract) which can modify the refractive power of the cornea (see column 13, lines 30-45) via ablation .

3. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bille et al ('586).

4. Bille et al teach a method of delivering an ablating laser beam to the cornea wherein the shots are placed in a manner wherein, inherently, the plumes of a specific pulse does not interfere with plumes of a subsequent pulse.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Isakov et al. Sklar et al teach a device as claimed except the specifically shifting of the beam resulting in a resulting beam path parallel

to the original beam path. Isakov et al teach a laser scanning method wherein the beam path at any given scan location is parallel to the beam path^s of all previous scan locations. It would have been obvious to the artisan of ordinary skill to employ the scanning method of Isakov et al in the method of Sklar et al, since Sklar et al teach no particular method for scanning the beam between points on the tissue, thus producing a method such as claimed.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,632,742 the claims. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

9. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,849,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

10. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/745,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely ^{an obvious} obvious change in scope in his is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,980,513. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

12. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 09/745,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

13. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of copending Application No. 09/745,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 09/745,194. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims ¹⁻¹⁰ ~~1-4~~ of copending Application No. 09/742,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims ¹⁻⁴ ~~1-10~~ of copending Application No. 09/742,884. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

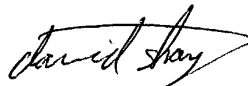
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 09/745,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The examiner acknowledge applicant information disclosure statements of May 7, 2001 and October 9, 2001. With respect to the submission of October 9, 2001 which appararently was not accompanied by copies of references, the examiner notes that the submission is not in conformance with MPEP 609. The examiner has considered the approximately 100 US and foreign patent references in the submission, however, the approximately 50 non-patent literature publications have not been considered. Further the reference to Pulimto (reference BG) in the May 7, 2001 submission is such a poor copy as to be virtually illegible and has thus not been considered.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215



David Shay:bhw

April 25, 2001

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330